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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,408	04/24/2001	Nick Merz	APL1P202/P2625	9091
22434	7590	04/08/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 778 BERKELEY, CA 94704-0778			LEA EDMONDS, LISA S	
			ART UNIT	PAPER NUMBER
			2835	
DATE MAILED: 04/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

8m

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/842,408	MERZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lisa Lea-Edmonds	2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-36 and 60-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-29, 31-36, 60, 63-68 and 70-73 is/are rejected.
- 7) ☐ Claim(s) 30, 61, 62 and 69 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 63, applicant is directed to MPEP section 608.01(v), and section 2173.05 (u). Claim 63 contains the trademark/trade name MYLAR. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a flexible film for packaging purposes; polyester film and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-28, 31-36, 60, 65-68, 70, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima (5715139) in view of Shih (6509981). With respect to claims 25-28, 32-36, 60, 65-68, 70, and 73, the apparatus of Nakajima teaches a portable computer (1) comprising a base (2) having casing (4, 5, 6) and a chassis (70) wherein the casing (4, 5, 6) is configured to house various components that provide computing operations for the portable computer (1) and the chassis (70) includes a plurality of ribs (74a, 74b, 75, 76) wherein at least one of the ribs (74a, 74b, 75, 76) forms a wall of the enclosed region and is configured to support the casing (4, 5, 6), the casing (4,5,6) and chassis (70) has interior portions that define an enclosed region inside the base (2); shield plates (78, 100, 101); and a disk drive (50) as claimed (see for example figures 1-47 with focus on figures 11-19 and column 6 line 39 through column 30 line 25). However, the apparatus of Nakajima lacks a clear teaching of an enclosureless optical disc drive and the internal portions of the casing and chassis that form the enclosed region being configured to shield electronic emissions therein as claimed. The apparatus of Shih is relied upon for its teaching of an enclosureless optical disc drive (3) having drive components and frame components configured to support the drive components and an internal portions (2) of the casing and chassis that form the enclosed region being configured to shield electronic emissions therein, as claimed (see for example figures 1-4). It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to incorporate the teachings of Shih into the apparatus of Nakajima as providing a user with a lighter disk drive system is mere routine in the art and would be considered a design choice. The apparatus of Nakajima as modified by Shih teaches the casing (4, 5, 6) and chassis (70) include a top wall for enclosing a top portion of the enclosureless optical disc drive (3), a bottom wall for enclosing a bottom portion of the enclosureless optical disc drive (3), a front wall for enclosing a front portion of the enclosureless optical disc drive (3), a first side wall for enclosing a first side portion of the enclosureless optical disc drive (3), a second side wall for enclosing a second side portion of the enclosureless optical disc drive (3), and a back wall for enclosing a back portion of the enclosureless optical disc drive (3); wherein the internal portions of the casing (4, 5, 6) and chassis (70) that form the enclosed region are configured to shield electronic emissions therein; wherein the chassis (70) is disposed within the portable computer enclosure; wherein the enclosed region shields the enclosureless optical disc drive from dust; wherein the enclosed region shields laser emissions; and wherein the optical disc drive is a CD/DVD drive as claimed. With respect to claim 36, it would have been obvious to one skilled in the art to select a slot loaded CD/DVD drive as the apparatus of Nakajima has a slot (54) for loading a disk therein. One skilled in the art would not be motivated to destroy the slot structure of Nakajima to provide the portable computer (1) with a tray loaded CD/DVD drive.

4. Claims 29, 64, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima as modified by Shih as applied to the claims above, and

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further in view of Chee et al. (6324054). With respect to claims 29, 64, 71 and 72, the apparatus of Nakajima as modified by Shih teaches the claimed invention as set forth above. However, Nakajima as modified by Shih lacks a clear teaching of a thin flexible boot as claimed. The apparatus of Chee et al. is relied upon for its teaching of a thin flexible boot (300) as claimed (see for example figures 3, 4, and 8-15). It would have been obvious to one having ordinary skill in the art to incorporate the teachings of Chee et al. into the apparatus of Nakajima as modified by Shih to provide the disk drive with shock absorbers.

5. Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima as modified by Shih as applied to the claims above, and further in view of Chee et al. (6324054). With respect to claim 63, the apparatus of Nakajima in view of Shih further in view of Chee et al. teaches the claimed invention as set forth above. However, Nakajima in view of Shih further in view of Chee et al. lacks a clear teaching of a thin flexible boot being MYLAR as claimed. It would have been obvious to one skilled in the art to use MYLAR, since applicant has not disclosed that MYLAR solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with MYLAR.

***Allowable Subject Matter***

6. Claims 30, 61, 62, and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. The following is a statement of reasons for the indication of allowable subject matter: as to claims 30, 61, and 62, patentability resides, at least in part, in the frame component including a bottom plate, a top plate, and a plurality of structural arms extending there between, in combinations with the other limitations of the claims; as to claim 69, patentability resides, at least in part, in the top cover including an extension for blocking laser light from emanating outside the optical drive, in combinations with the other limitations of the claims.

### ***Response to Arguments***

8. Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive. With respect to applicant's use of the Trademark or Trade Name "MYLAR", MPEP section 2173.05(u) entitled Trademark or Trade Name in a Claim, states where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. Thus the rejection stands. With respect to applicant's remarks concerning claims 25-28, 31-36, 60, 65-68, 70 and 73 as being unpatentable over Nakajima in view of Shih; applicant argues "Neither reference teaches or suggests "an enclosureless drive" let alone "...and enclosureless optical drive having drive components and same components configured to support the drive components, the frame components taking the form of a skeletal system..." In addition, neither reference teaches or suggests, "...the casing and chassis having interior portions that define an enclosed region inside the base... the enclosed region being arranged to surround a substantial portion of the enclosureless optical disc drive so as to shield the

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enclosureless optical disc drive from internal and external hazards capable of passing through the skeletal system of the frame components," as required by claim 25 and its dependents and "...an optical drive including internal components and frame components configured to support the internal components, the frame components having one or more openings that leave at least a portion of the internal components of the optical drive exposed, the optical drive being disposed inside the enclosed region of the base, the enclosed region being dimensioned to surround the peripheral regions of the optical drive so as to cover at least the exposed portions of the optical drive and to shield the optical drive from internal and external hazards. . ." as required by claim 66. It is the position of the examiner of record that the combined teachings of Nakajima in view of Shih not only suggest, but also teaches applicant's claimed invention as set forth in claim 25 and its dependents. Shih teaches an optical media access device (1), having an enclosureless drive (3). By "enclosureless" applicant means that the drive does not include its own housing (see page 8 lines 11-12 of applicant's remarks dated 9/22/03 and page 8 line 8-9 of applicant's specification. It is clear to the examiner of record that the optical media access device 1 of Shih includes a fixed housing (2), and a moveable housing (3) having a tray (5) for holding the optical disk therein (see for example figure 1). However, only the moveable housing (3) includes the drive components and frame components configured to support the drive components as claimed (see for example figures 3-4). "As shown in the figures, the fixed housing (2) is made from metallic material and is provided with a mounting hole such that the fixed housing can be disposed within the mounting slot of a computer. The way of mounting



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the fixed housing (2) is similar to the mounting of an optical driver. The fixed housing (2) is functioned to protect the parts within the housing (2) and also is used to shield interference of electromagnetism." (sic. see column 2 lines 41-48). It is clear to the examiner that the fixed housing (2) is disposed within the mounting slot of a computer, thus becoming part of the computer's case and chassis structure and not part of the movable optical drive structure as argued by applicant. Given the fact that the fixed housing (2) is mounted in the computer and the movable housing (3) contains the internal mechanisms of the optical media device, the examiner believes Shih teaches applicant's enclosureless optical drive as defined and claimed. With respect to applicant's remarks concerning claims 29, 63, 64, 71 and 72, as being unpatentable over Nakajima in view of Shih further in view of Chee; applicant argues in addition to the above stated arguments, Chee fails to disclose "a thin flexible boot configured to surround at least a portion of the enclosureless optical disc drive so as to prevent particles from reaching the drive components," as required by claim 29 as well as "...a flexible sheath for surrounding at least a portion of the optical drive in order to prevent dust and loose particles from reaching the internal components of the optical drive wherein the thin flexible sheath is sized to fit over the frame components so as to cover exposed portions of the optical drive," as required by claim 71. The examiner believes Chee teaches such a thin flexible boot and/or sheath in that the flexible boot and/or sheath (300) of Chee is made of a natural or synthetic rubber (or its compounds) or plastic (see for example column 4 line 65 through column 5 line 5). With respect to applicant's remarks concerning claim 63 and the use of MYLAR, it is noted that MYLAR

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is a trademark, which does not impart structural limitations. Thus, applicant's remarks are considered moot, in that applicant is arguing limitations not claimed.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Lea-Edmonds whose telephone number is 571-272-2043. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on (571) 272-2800, ext 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lisa Lea-Edmonds  
Primary Examiner  
Art Unit 2835